

## REMARKS

Claims 1-6, 8, 9, 12, 13, 15-28, 32-34, 36-39, 42-49, 51-54, 58-61, 65 and 67-69 are pending in the above application. Claims 1-6, 8, 9, 12, 13, 15-28, 32-34, 36-39, 42-49, 51-54, 58-61, 65 and 67-69 have been rejected in the present Office Action. Claims 1, 25, 26, 33, 37, 42, 46, 52, 58, 67 and 68 have been amended herein. Applicants respectfully traverse each ground of rejection and respond to each ground of rejection and objection as follows:

1. **Claims 1-6, 8, 9, 12, 13, 15, 19-21, 24-28, 32-34, 37-39, 42-44, 46-49, 51-54, 58-61, 65 and 67-69 stand rejected under 35 USC §103(a) as being unpatentable over LeRoy (US 5,970,474) in view of Robertson (US 6,609,106) and further in view of Business Wire (PTO-892, Item U) and Official Notice (Paper #20041223, admitted regarding well within the skill, hereinafter referred to as “ON1”).**

LeRoy discloses a system that allows users to use a product selection device to choose items in a retail store. The items are then communicated to a registry database on a host computer via a local area network (LAN). The registry database includes items that a user has selected using the product selection device. LeRoy also discloses a point of sale input device that identifies purchased items and updates the registry database to indicate which items have been purchased. LeRoy further discloses a system whereby registry databases at individual retail stores can be synchronized with a master registry database across a wide area network (WAN), such as the Internet.

Robertson discloses a system and method that allows users to create a gift registry including products from multiple on-line merchants. The selected items are then stored centrally in a database as elements of a wish list by sending information over the Internet to a centralized gift registry site. Robertson also discloses a system whereby individual gift purchasers can make purchases for a registrant using the wish list. The wish list items can be searched and organized

by price or category. Robertson also discloses that the purchase of all items in the wish list can be delayed to a certain specified date corresponding to a future time or event. Additionally, registrants of the system can receive an automatic notification upon the arrival of the specified time or event.

ON1 asserts that “it is well within the skill to ascertain that accepted business retail practices allow potential gift registry registrants to physically collect item information in a store prior to registering, in order to allow a potential registrant an opportunity to determine whether the retailers goods are suitable to the potential registrant’s wish list.”

In a previous Response, Claims 1, 26, 37, 46 and 58 were amended to include the limitation of include “wherein the processor is further programmed to transmit items selected for purchase by a buyer to a concierge service”. Applicant respectfully asserts that a concierge is more than simply another category of buyer as disclosed in the present application. Rather, a concierge is an expert in current styles and trends in a wide variety of consumer products including clothing, music, perfumes, jewelry, and other product categories.

A buyer uses the services of a concierge when he is unsure as to what qualities such as color or style to choose when selecting an appropriate gift. A concierge does more than simply purchase a specific stem from a list when the ultimate buyer does not have the time to perform that task directly, although a concierge’s duties can include this limited service. Rather, using information about the intended recipient’s style and tastes, a concierge can select an appropriate gift item from a class of items. For example, a buyer may simply instruct the concierge to purchase a pair of shoes for a gift. The concierge, by using information about the intended recipient, selects a specific pair of tan Oxford-style shoes that are appropriate for the style and

tastes of the recipient. Claims 1, 26, 37, 46 and 58 have been amended by the present Response to more clearly reflect the role that the skills of a concierge play in the present invention.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the Claim limitations. MPEP § 706.02(j). Specifically, the combination cited in the most recent Office Action does not teach transmitting a buyer's selections to a concierge service or personal shopper where a concierge then selects a specific item from a class of items so as to make a physical purchase of an appropriate gift on behalf of a buyer or listed user. Therefore, a prima facie case of obviousness has not been made. The cited references do not, alone or in combination, disclose, teach or suggest the combination of elements of Claims 1, 26, 37, 46 and 58. It is therefore respectfully submitted that Claims 1, 26, 37, 46 and 58 are allowable over the above-cited art. It is respectfully requested that the above rejection be withdrawn.

Claims 2-6, 8, 9, 12, 13, 15, 19-21 and 24-25 depend from Claim 1 and therefore include all of the limitations of Claim 1. Claims 27-28 and 32-34 depend from Claim 26 and therefore include all of the limitations of Claim 26. Claims 38-39 and 42-44 depend from Claim 37 and therefore include all of the limitations of Claim 37. Claims 47-49 and 51-54 depend from Claim 46 and therefore include all of the limitations of Claim 46. Claims 59-61, 65 and 67-69 depend from Claim 58 and therefore include all of the limitations of Claim 58. It is therefore respectfully submitted that Claims 2-6, 8, 9, 12, 13, 15, 19-21, 24-25, 27-28, 32-34, 38-39, 42-44, 47-49, 51-54, 59-61, 65 and 67-69 are allowable over the cited references for at least the same reasons as set forth above regarding Claims 1, 26, 37, 46 and 58.

2. **Claim 16 stands rejected under 35 USC §103(a) as being unpatentable over LeRoy (US 5,970,474) in view of Robertson (US 6,609,106) and further in view of Business Wire (PTO-892, Item U) and ON1, as applied to Claim 15, further in view of Schwartz et. al. (US 5,913,032, hereinafter referred to as “Schwartz”).**

Claim 16 depends from Claim 1 and therefore includes all of the limitations of Claim 1.

It is therefore respectfully submitted that Claim 16 is allowable over the cited references for at least the same reasons set forth above regarding Claim 1.

3. **Claims 17, 36 and 45 stand rejected under 35 USC §103(a) as being unpatentable over LeRoy (US 5,970,474) in view of Robertson (US 6,609,106) and further in view of Business Wire (PTO-892, Item U) and ON1, as applied to Claims 15, 26 and 44, further in view of Official Notice (Paper #20041223, admitted regarding well within the skill, hereinafter referred to as “ON4”).**

Claim 17 depends from Claim 1 and therefore includes all of the limitations of Claim 1.

Claim 36 depends from Claim 26 and therefore includes all of the limitations of Claim 26.

Claim 45 depends from Claim 37 and therefore includes all of the limitations of Claim 37. It is therefore respectfully submitted that Claims 17, 36 and 45 are allowable over the cited references for at least the same reasons set forth above regarding Claims 1, 26 and 37.

4. **Claim 18 stands rejected under 35 USC §103(a) as being unpatentable over LeRoy (US 5,970,474) in view of Robertson (US 6,609,106) and further in view of Business Wire (PTO-892, Item U) and ON1, as applied to Claim 1, further in view of Wireless Data News (Paper #20041223, PTO-892 Item U, hereinafter referred to as “WDA”).**

Claim 18 depends from Claim 1 and therefore includes all of the limitations of Claim 1.

It is therefore respectfully submitted that Claim 18 is allowable over the cited references for at least the same reasons set forth above regarding Claim 1.

5. **Claims 22 and 23 stand rejected under 35 USC §103(a) as being unpatentable over LeRoy (US 5,970,474) in view of Robertson (US 6,609,106) and further in view of Business Wire (PTO-892, Item U) and ON1, as applied to Claim 1, further in view of Official Notice (#20041223, admitted regarding well within the skill, hereinafter referred to as “ON5”).**

Claims 22 and 23 depend from Claim 1 and therefore include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 22 and 23 are allowable over the cited references for at least the same reasons set forth above regarding Claim 1.

## **CONCLUSION**

Applicant has amended claims 1, 25, 26, 33, 37, 42, 46, 52, 58, 67 and 68, canceled no claims, and added no claims. Applicant respectfully requests a Notice of Allowance for pending claims 1-6, 8, 9, 12, 13, 15-28, 32-34, 36-39, 42-49, 51-54, 58-61, 65 and 67-69. The undersigned welcomes a telephonic interview with the Examiner, if the Examiner believes that such an interview would facilitate review of this Amendment Response. Applicant requests a three-month extension of time. The Commissioner is authorized to charge this extension fee to Deposit Account No. 50-0410. No additional fees are believed to be necessary; however, should any fees be deemed required, please charge such fees to Deposit Account No. 50-0410, but not to include any payment of issue fees.

Respectfully submitted,

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